

Application of Mark Gottlieb et al.  
Serial No.: 10/776,201  
Filed: February 12, 2004  
Reply to Office Action of October 23, 2006

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 1, 3-7, 9, 12-31 and 33-51 are currently pending in the application. Claims 1, 5, 6, 9, 19, 20, 28, 30, 31, 39 and 48-51 have been amended herewith. The amendments to the independent claims are supported by claims 5, 8 and 10. Accordingly, no new matter has been added. The changes are believed to be consistent with the previously performed search, and thus consideration of this amendment is proper even after a final rejection.

In general, the independent claims have been amended to further accentuate that a set of communications devices is selected from among the communications devices that are in a communications range by using user interface to create a list. The voice communication from the communications device is then sent to the communications devices in the communications range and output only on the speakers of the selected communications devices.

In the outstanding Office Action, the claims were rejected under 35 U.S.C. § 103(a) as being obvious over various combinations of references. However, in light of the amendments to the claims, it is believed that it is only necessary to discuss the rejection of claims 5, 8-14 and 18-20 under 35 U.S.C. § 103(a) as being obvious over the combination of four U.S. Patent Publications: 2004/0203363, 2004/0015553, 2002/0122410 and 2002/0006804, which will each be referred to hereinafter by their last three digits. When discussing claim 1, the Office Action alleges that the '363 publication comprises a "transmitter ... configured to transmit a control signal .. and a voice signal (a song is made up of voice which reads on a voice signal)." However, such an assertion ignores that later claim 1 recites that "the computational unit is configured to control the transmitter and the microphone to transmit the voice communication [from the microphone] as the first voice signal while the transmit button is selected by the user to the selected set of digital communication devices." Thus, it is inappropriate, even under the broadest reasonable interpretation, to assert that the '363 patent discloses a transmitter and computational unit as claimed. Similarly, the receiver of the '363 publication does not receive

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the voice communication because it does not disclose a microphone to produce the claimed voice communication such that it can be received. (In fact, the '363 publication does not disclose voice or a microphone at all.) Therefore, the '363 publication also does not include a speaker outputting the claimed voice signal/voice communication as it is not received by the receiver.

The Office Action also admits that the '363 publication does not disclose a user interface including a transmit button such that the transmitter and microphone are configured to transmit the voice communications as the first voice signal while the transmit button is selected by the user. The Office Action alleges that the '553 publication instead teaches such a limitation and that it would have been obvious to combine the '363 and '553 publications in order to "make it easier for buddies, friends or members of a group to communicate with each other." This assertion, however, is without support. The '363 patent is directed to match-making devices, and the Office Action has not provided a supportable rationale why in the personal arena of match-making one would want to talk to buddies, friends or members of a group as a group.

The Office Action also alleges that one of ordinary skill in the art would have been motivated to combine the '363 and '553 publications with the '410 publication. In general, given that the '553 publication already can transfer text and voice, it is unclear why one of ordinary skill in the art would have looked to incorporating the teachings of the '410 publication. Even the identified motivation (i.e., that the combination "allows the devices to communicate among one another without the fixed towers since the devices can reduce their power consumption due to a lower transmission power required") does not cite to any evidence tending to prove that such a result would be achieved as compared to the '363 and '553 publications alone.

The Office Action then also attempts to combine the '804 publication with the other publications in order to "have a blocked list to exclude certain other devices from communicating to promote privacy." However, such a motivation contradicts the previous motivation of claim 1 of adding more people in order to "make it easier for buddies, friends and members of a group to communicate with each other." Furthermore, the '804 publication was

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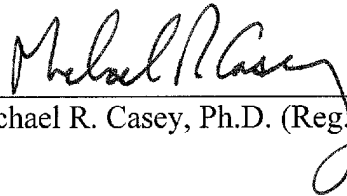
available to the inventors of the '553 publication before they filed, and even they did not see fit to combine the teachings in the fashion proposed by the Office Action.

It is respectfully submitted that the motivation to combine the four applied references is not based on what one of ordinary skill in the art would have done had he or she had the four applied references before him or her at the time of filing. Instead, as evidenced by the usage of contradictory motivations, the applied combination of references appears to be achieved only by using the Applicant's specification as a roadmap to achieve the advantages and functionality described in his invention.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome and in condition for allowance. An early and favorable action to that effect is respectfully requested. The changes are believed to be consistent with the previously performed search, and thus consideration of this amendment is proper even after a final rejection.

Respectfully submitted,

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